

R E M A R K S

Claims 98-103, 105, 113 and 121 are pending in the present application.

Both the parent application and this application describe methods and advices for performing cell migration assays. The instant application describes additional embodiments for cell migration assays, including the use of particular cell seeding device embodiments for confining cells to a predetermined area in a well. Related U.S. applications and issued patents are as follows: 7,018,838; 11/342,413; 11/890,740; and 12/195,007.

The following rejections are at issue:

1. Claims 98-101, 103, 105, 113 and 121 are rejected under 35 USC 103 as being obvious over U.S. Appl. No. 2008/0187949 (Goldbard) in view of U.S. Pat. No. 6,171,780 (Pham); and
2. Claim 102 is rejected under 35 USC 103 as being obvious over U.S. Appl. No. 2008/0187949 (Goldbard) in view of U.S. Pat. No. 6,171,780 (Pham) and WO 99/63329 (Abbott).

1. Claims 98-101, 103, 105, 113 and 121 are not obvious

Claims 98-101, 103, 105, and 121 are rejected under 35 USC 103 as being obvious over U.S. Appl. No. 2008/0187949 (Goldbard) in view of U.S. Pat. No. 6,171,780 (Pham). Applicants respectfully disagree. A *prima facie* case of obviousness requires the Examiner to cite a combination of references which (a) disclose the elements of the claimed invention, (b) suggests or motivates one of skill in the art to combine those elements to yield the claimed combination, and (c) provides a reasonable expectation of success should the claimed combination be carried out. Failure to establish any one of the these three requirements precludes a finding of a *prima facie* case of obviousness, and, without more, entitles Applicant to allowance of the claims in issue. In addressing this rejection, Applicants focus on the independent claims since non-obviousness of an independent claim necessarily leads to non-obviousness of claims dependent therefrom.

Applicants respectfully submit that the Examiner has not established a prima facie case of obviousness because the cited references do not teach element of the claims. The claims are methods claims and include the steps of:

- b) inserting the insert into at least one well of said multiwell plate, wherein the insert contacts said bottom surface of the well to define a discrete location on the bottom surface of the well;
- c) contacting seeding the cells in the well in the multiwell plate;
- d) incubating said cells with the insert in the well;
- e) removing the insert, wherein the seeded cells are confined to a discrete location defined by the insert;

Applicants respectfully submit that the cited references, alone or in combination, do not at least the steps of:

- d) incubating said cells with the insert in the well;
- e) removing the insert, wherein the seeded cells are confined to a discrete location defined by the insert.

The Examiner has failed to identify where the cited prior art teaches these particular steps. The insert which is defined in the claims is not taught by the cited references and the use of the insert as defined in steps d and e is not taught by the cited references. The insert is not simply a pipette as argued by the Examiner. The prior art (Goldbard and Pham) does not teach **leaving the pipette in the well following application of cells to the well and culturing the cells in the presence of the pipette so that the cells are confined to an area defined by the pipette**. The cited references also fail to teach an insert as defined in the claims and as previously argued by Applicants.

In response to Applicants previous arguments, the Examiner states:

It is the examiner's position that applying cells to a well with a device does not lend patentability and is found in numerous references cited herein. Regarding Goldbard specifically, in paragraph 19 the wells are described that permit and restrict cell migration and passive movement of cells. See paragraph 21 which further describes the wells permitting migratory loss of cells from subcompartments and localization of cells to subregions. Pham teaches in column

3 lines 31-34, cells in multiwell plates which are assayed. Pham and Abbott were not cited to teach confining cells to a predetermined area on the bottom surface of a well. A pipette has an opening of predetermined area and when cells in solution are placed in a well with a pipette, the cells are inherently confined to a discrete location within that well.

Again, nowhere in this statement or elsewhere in the Office Action does the Examiner identify where the prior art teaches steps d and e. In the claimed methods, the cells are cultured in the presence of the insert. The insert is not used merely to apply cells to the well as a pipette would be used.

Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness because the references, alone or in combination, do not teach each element of the claims. Applicants respectfully request that this rejection be withdrawn.

2. Claim 102 is not obvious

Claim 102 is rejected under 35 USC 103 as being obvious over U.S. Appl. No. 2008/0187949 (Goldbard) in view of U.S. Pat. No. 6,171,780 (Pham) and WO 99/63329 (Abbott). Abbott does not cure the defects noted for the combination of Goldbard and Pham. In particular, Abbott does not disclose any method for confining cells to a predetermined area on the bottom surface of a well so that migration outside of the predetermined area can be assayed. Accordingly, Applicants respectfully request that this rejection be withdrawn.

C O N C L U S I O N

All grounds of rejection and objection of the Office Action of June 28, 2010 having been addressed, reconsideration of the application is respectfully requested. It is respectfully submitted that the invention as claimed fully meets all requirements and that the claims are worthy of allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicant encourages the Examiner to call the undersigned collect at (608) 662-1277.

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